



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/020,699	02/09/98	SLATER	R 7204

TM02/1107

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EXAMINER

ELMORE, R

ART UNIT

PAPER NUMBER

2187

DATE MAILED:

11/07/00

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/020699

Applicant(s)

SLATER et al.

Examiner

R. ELMORE

Group Art Unit

2187

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/21/2000
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1:1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-2 and 4-20 is/are pending in the application.
- Of the above claim(s) is/are withdrawn from consideration.
- ☒ Claim(s) 1-2, 4-13 + 17-20 is/are allowed.
- ☒ Claim(s) 14-16 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Part III DETAILED ACTION

1. The office action is in response to the appeal brief filed

Drawings

2. Figures **1 and 2** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. This figure(s) is described in the background of the specification and in the brief description of the drawings section this figure(s) is not described as being 'according to the present invention'. This figure(s) appears to be "Prior Art" and must be labeled as such to clearly indicate applicant's invention. See MPEP § 608.02(g).

None of the figures are designated as showing an embodiment of the present invention. This designation would not overcome the objection to figures 1 and 2. Neither figure shows the elements applicant is arguing as the patentable features of the present invention. Figure 1 is merely a housing and Figure 2 shows elements common to all ATMs. The present invention is claimed as a method in most of the claims and as a system with very specific processing functions in the rest of the claims. None of this is shown in Figures 1 and 2.

This is an objection which would not be decided by the Board of Appeals and Interferences.

Correction is required.

Specification

3. The objection relating to claim 2 for lacking antecedent basis within the specification is ***maintained***. Applicant has not addressed this objection within the response.

Please add this information to the body of the specification. This is an objection which would not be decided by the Board of Appeals and Interferences.

Correction is required.

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112, 1st

5. The rejection to claim 17 under *35 USC § 112, 1st paragraph* is *withdrawn* due to the applicant's arguments.

Claim Rejections - 35 USC § 103

6. The rejection to claims 1-2, 6-13 and 17-19 under *35 USC § 103(a)* as being unpatentable over Suzuki is *withdrawn*.

7. The previous rejections are *maintained* for claims 14-16. These rejections have been rewritten to more specifically address these claims only.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki**.

Suzuki teaches the claimed invention (claim **14**) substantially as claimed including a **method of determining validity of a transaction carried out by a user at a data processing system, the method including the steps of:**

- a. accepting a user identification card from a party is taught as an IC card (e.g., see col. 1, lines 25-38);
- b. reading first and second data from the card is inherently taught;
- c. prior to asking for any other identity data, presenting a message asking the party to enter the first data is notoriously well known as requesting a PIN in the ATM art and official notice is taken thereof;
- d. comparing the first entry of data against a first stored field of security data is taught as determining the validity of the entered PIN (e.g., see Figure 3 and col. 3, lines 3-12); and,
- e. comparing the second data entered with the second data read from the card and if they agree, proceeding with the transaction is taught as doing the comparison of the additional personal data supplied by the card owner (e.g., see col. 2, lines 25-49).

Suzuki teaches the above listed details of the claim **14**, however, **Suzuki** does not teach using the second data as an additional means of identification but as a means of the card owner still having access when the PIN has been forgotten or incorrectly typed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use this

second data as a further identification means for security purposes to insure against misuse of an IC card without incurring significant requirements for either additional hardware or software.

As to claim 16, Suzuki teaches suspending the transaction if there is lack of agreement between the entered data and the stored data (e.g., see Figure 3).

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki in view of Chapin, Jr. et al.**

Suzuki teaches the independent claim 14 as shown above.

As to claim 15, Suzuki does not teach the first and second data on the card being encrypted, however, Chapin, Jr. teaches the encryption of data on transaction card (e.g., see the abstract and col. 3, lines 8-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the encryption of the data on the card with the invention as taught by Suzuki because this provides additional security and thereby prevents possible misuse of the card. It would be reasonable to combine these references particularly in light of Suzuki stating the data is 'coded' which indicates more than direct storage of data (e.g., see col.1, line 56 to col. 2, line 11).

Response to Applicant's Remarks

11. The objections to the drawings and to the specification are not appealable to the Board of Appeals and Interferences. However, these objections are petitionable to the director of the Technical Center 2100.

12. Elements which are considered to read over the art of record include the subset entry consisting of less than all the characters of a second stored field of security data and the limitations dealing with the aspects of guessing as opposed to a keying error.

13. This response is being sent as opposed to an examiner's answer being written to clearly show the issues which need consideration by the Board of Appeals and Interferences. Since the examiner has agreed with allowability of previously rejected claims the issues before the Board can be greatly reduced.

14. This action is being made final, however, if the applicant resolves the objections maintained in this office action and either cancels claims 14-16 or amends them to include the subject matter considered patentable over the art of record and the case is thereby made allowable, PTO fees for appealing the examiner's rejection to the Board are refundable. No further fees to the PTO for appealing the examiner's rejection of claims 14-16 will be required over the fees for the current request for appeal to the Board.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Serial Number: 09/020,699

7

Art Unit: 2187

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reba I. Elmore, whose telephone number is (703) 305-9706. The examiner can normally be reached on M-THU from 7:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by phone fail, the art unit supervisor, Do Yoo, can be reached at (703) 308-4908. Additionally, the fax phone for Art Unit 2187 is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-3800.



Reba I. Elmore
Primary Patent Examiner
Art Unit 2187

**REBA I. ELMORE
PRIMARY EXAMINER
GROUP 2100**